

Remarks

The Applicant wishes to thank Examiner Nguyen for the courtesy of extending an Examiner Interview to Applicant's representative James J. Bindseil on August 24, 2006. The interview was helpful in discussion amendments to overcome the cited prior art references.

Claims 1-5, 7 and 9-28 are pending in the application. As noted above, claims 1, 12-14, 16 and 26 have been amended, claims 2-11 and 15 have been canceled, claims 29-51 have been added, and claim 28 stands withdrawn. The amendments to the claims are supported throughout the specification, and these amendments do not include any new matter or raise any new issues. Thus, after entry of this Amendment, claims 1, 12-14 and 16-51 will be pending in the present application.

Rejections under 35 USC § 103(a) based on Furuta, Goldman and Guidi

The examiner has rejected claims 1-2, 4-5, 7 and 9-14 under 35 USC § 103(a) as being obvious over Furuta et al (US 2003/094761) in view of Goldman (US 5,997,002) and further in view of Guidi (US 5,839,732). The Applicant respectfully traverses this rejection.

This rejection is moot with respect to claims 2, 4-5, 7 and 9-11, as these claims have been canceled.

Further, the Applicant submits that Furuta, Goldman and Guidi, in any combination, do not disclose or suggest the method for playing a card game as recited by claim 1. In particular, none of the references disclose or suggest a card game comprising a Poker game and an auxiliary play, where the Poker game is played according to the standard rules of Poker and has at least five cards per hand, and where the auxiliary play is based on the hand of the respective player in the Poker game, wherein the auxiliary play comprises a bonus prize corresponding to each hand having four royal cards out of the at least five cards, wherein the four royal cards comprise any four of an ace, a king, a queen, a jack, and a ten, and wherein the four royal cards comprise cards of the same suit, wherein the recited selections, taking of wagers and removing players from the games occur, and wherein the card game payout corresponding to each hand is determined regardless of a dealer hand.

Additionally, the Applicant submits that the examiner has failed to establish a *prima facie*

case of obviousness for the claimed subject matter. Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation or suggestion in the reference to do so.¹ The PTO can satisfy this burden only by showing some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references.² Further, it is well settled that the mere fact that the prior art *could be* modified does not make the modification obvious unless the prior art has suggested the desirability of the modification.³

In the Office Action, the examiner merely states that the recited subject matter is obvious in light of the cited references.⁴ The examiner does not provide any factual basis of any suggestion in the prior art for such a modification. This is an insufficient showing of motivation.

Additionally, the Applicant submits that no factual basis of any motivation or suggestion for the modification proposed by the examiner exists in the references. Thus, a *prima facie* rejection cannot be established with any combination of Furuta, Goldman and Guidi.

Therefore, based on the above remarks, the Applicant respectfully requests that the examiner withdraw the rejection of claims 1-2, 4-5, 7 and 9-14 under 35 USC § 103 (a) as being obvious over Furuta in view of Goldman and further in view of Guidi.

Rejections under 35 USC § 103(a) based on Furuta and Guidi

The examiner has rejected claims 3 and 15-27 are rejected under 35 USC § 103(a) as being obvious over Furuta et al (US 2003/094761) in view of Guidi (US 5,839,732). The Applicant respectfully traverses this rejection.

¹ See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

² *Id.*

³ *In re Gordon* (emphasis added).

⁴ See, e.g., Office Action at page 3.

This rejection is moot with respect to claims 3 and 15, as these claims have been canceled.

Further, the Applicant submits that Furuta and Guidi, in any combination, do not disclose or suggest the method for playing a card game as recited by claim 1. In particular, none of the references disclose or suggest a card game comprising a Poker game and an auxiliary play, where the Poker game is played according to the standard rules of Poker and has at least five cards per hand, and where the auxiliary play is based on the hand of the respective player in the Poker game, wherein the auxiliary play comprises a bonus prize corresponding to each hand having four royal cards out of the at least five cards, wherein the four royal cards comprise any four of an ace, a king, a queen, a jack, and a ten, and wherein the four royal cards comprise cards of the same suit, wherein the recited selections, taking of wagers and removing players from the games occur, and wherein the card game payout corresponding to each hand is determined regardless of a dealer hand

Additionally, the Applicant submits that the examiner has failed to establish a *prima facie* case of obviousness for the claimed subject matter. Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation or suggestion in the reference to do so.⁵ The PTO can satisfy this burden only by showing some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references.⁶ Further, it is well settled that the mere fact that the prior art *could be* modified does not make the modification obvious unless the prior art has suggested the desirability of the modification.⁷

In the Office Action, the examiner merely states that the recited subject matter is obvious in light of the cited references.⁸ The examiner does not provide any factual basis of any

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⁶ *Id.*

⁷ *In re Gordon* (emphasis added).

⁸ See, e.g., Office Action at page 4.

suggestion in the prior art for such a modification. This is an insufficient showing of motivation.

Additionally, the Applicant submits that no factual basis of any motivation or suggestion for the modification proposed by the examiner exists in the references. Thus, a *prima facie* rejection cannot be established with any combination of Furuta, Goldman and Guidi.

Therefore, based on the above remarks, the Applicant respectfully requests that the examiner withdraw the rejection of claims 3 and 15-27 under 35 USC § 103 (a) as being obvious over Furuta in view of Guidi.

New Claims

The Applicant has added new claims 29-51 to recite subject matter to which he is entitled. New claims 29-31 are fully supported throughout the specification, and these amendments do not include any new matter or raise any new issues. Further, the Applicant submits that new claims 29-51 are allowable over any combination of the cited prior art.

In particular, claims 29-31 depend from claim 1, and thus are allowable for the same reasons as discussed above.

Further, claims 32-52 are allowable over the cited prior art as Furuta, Goldman and Guidi, in any combination, do not disclose or suggest the method, system and device as recited by these claims.

In particular, with respect to claims 32-47, Furuta, Goldman and Guidi, in any combination, do not disclose or suggest the method of playing a card game comprising:

dealing to at least one player a hand of at least five cards from at least one deck of playing cards;

establishing a card game including each respective hand, wherein the card game comprises a Poker game portion and an auxiliary game portion, wherein the Poker game portion is playable in conjunction with the standard rules for Poker and comprises a Poker game payout, wherein the auxiliary game portion comprises a bonus prize, wherein both the Poker game payout and the bonus prize are based on the at least five cards in each respective hand, wherein the bonus prize corresponds to each respective hand having four royal cards out of the at least

five cards, wherein the four royal cards comprise any four of an ace, a king, a queen, a jack, and a ten, and wherein the four royal cards comprise four cards of the same suit;

for the Poker game portion of the card game, determining the Poker game payout for each hand based on the at least five cards in the respective hand; and

for the auxiliary game portion of the card game, determining the bonus prize for each hand based on any four of the at least five cards in the respective hand comprising the four royal cards, as recited by these claims.

Similarly, with respect to claims 48-49, Furuta, Goldman and Guidi, in any combination, do not disclose or suggest the system for playing a card game comprising:

at least one input device for at least one player to input data for playing the card game comprising representations of cards;

a processor coupled to the at least one input device for receiving input data from the at least one input device; and

at least one display device coupled to the processor for displaying display information;

wherein the processor is operable to:

deal to each player a hand of at least five cards from at least one deck of playing cards;

establish the card game with respect to each respective hand, wherein the card game comprises a Poker game portion and an auxiliary game portion, wherein the Poker game portion is playable in conjunction with the standard rules for Poker and comprises a Poker game payout, wherein the auxiliary game portion comprises a bonus prize, wherein both the Poker game payout and the bonus prize are based on the at least five cards in each respective hand, wherein the bonus prize corresponds to each respective hand having four royal cards out of the at least five cards, wherein the four royal cards comprise any four of an ace, a king, a queen, a jack, and a ten, and wherein the four royal cards comprise four cards of the same suit;

for the Poker game portion of the card game, determine the Poker game payout for each hand based on the at least five cards in the respective hand; and

for the auxiliary game portion of the card game, determine the bonus prize for each hand based on any four of the at least five cards in the respective hand comprising the four royal cards, as recited by these claims.

Additionally, with respect to claims 50-51, Furuta, Goldman and Guidi, in any combination, do not disclose or suggest the device for playing a card game, comprising:

at least one input device for at least one player to input data for playing the card game comprising representations of cards;

a payment mechanism operable to receive a payment from the at least one player;

a processor coupled to the at least one input device for receiving input data from the at least one input device; and

at least one display device coupled to the processor for displaying display information;

wherein the processor is operable to:

deal to each player a hand of at least five cards from at least one deck of playing cards;

establish the card game with respect to each respective hand, wherein the card game comprises a Poker game portion and an auxiliary game portion, wherein the Poker game portion is playable in conjunction with the standard rules for Poker and comprises a Poker game payout, wherein the auxiliary game portion comprises a bonus prize, wherein both the Poker game payout and the bonus prize are based on the at least five cards in each respective hand, wherein the bonus prize corresponds to each respective hand having four royal cards out of the at least five cards, wherein the four royal cards comprise any four of an ace, a king, a queen, a jack, and a ten, and wherein the four royal cards comprise four cards of the same suit;

for the Poker game portion of the card game, determine the Poker game payout for each hand based on the at least five cards in the respective hand; and

for the auxiliary game portion of the card game, determine the bonus prize for each hand based on any four of the at least five cards in the respective hand comprising the four royal cards.

Additionally, for the same reasons as stated above, there is no motivation to combine Furuta, Goldman and Guidi, and thus a *prima facie* rejection of new claims 29-51 is not possible with that combination of prior art.

Thus, for at least these reasons, new claims 29-51 define over the cited prior art and the Applicant respectfully requests that the examiner allow these claims.

Conclusion

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN & BERNER, LLP

A handwritten signature in black ink, appearing to read "James J. Bindseil". The signature is fluid and cursive, with the first name "James" and last name "Bindseil" clearly distinguishable.

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